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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,814	03/31/2004	Sandra Cotten	MASSCO.013A	5296

20995 7590 06/12/2008  
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EXAMINER
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ANDREI, RADU

ART UNIT	PAPER NUMBER
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4137

NOTIFICATION DATE	DELIVERY MODE
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06/12/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/814,814	<b>Applicant(s)</b> COTTEN ET AL.	
	<b>Examiner</b> RADU ANDREI	<b>Art Unit</b> 4137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 26-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 26-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/31/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/07/2004; 08/29/2005; 07/13/2006; 02/23/2007;</u>           | 6) <input type="checkbox"/> Other: _____                          |
| <u>05/17/2007.</u>   |   |



### **DETAILED ACTION**

1. This office action is in response to Applicant's restriction response from 05/01/2008. Claims 26-36 are pending and are considered below.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26-8 and 30-36 are rejected under 35 U.S.C. 103(a) as being obvious in view of Toader et al. (US Patent No. 5,749,075) ("Toader") and of Kazaks et al. (US Patent Application Publication No. 2002/0046341) ("Kazaks").

4. Regarding claim 26, Toader discloses: A method of incentivizing future purchases by customers, said method comprising:

- a) providing an inactivated purchase card to a customer, wherein said purchase card displays a an identification number for the customer to visit; (col 5, lns 4-30)
- b) receiving a call from the customer; (col 5, lns 18-20)
- c) receiving from the customer during the call a card identification number associated with said purchase card; (col 5, lns 20-27)

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- d) providing to the customer during said visit one or more survey questions; (fig 1, elm 11; col 4, lns 5-19)
- e) receiving from the customer during said visit responses to said survey questions; and (fig. 1, elm 5; col 5, ln 67 to col 6, ln 8)
- f) activating said purchase card with a predetermined value in response to receiving one or more responses from the customer to said survey questions. (col 6, lns 4-7)

Toader does not specifically disclose a web site to be visited for registering the card or for shopping. However, Kazaks discloses web sites to register purchasing cards, to shop and to provide/receive further information ([0021], [0041], [0046]). Thus, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Toader's teachings with Kazaks'. This creates more customer convenience and a better service.

5. Regarding claim 27, Toader discloses: The method of Claim 26, wherein said purchase card is provided to the customer only if the customer satisfies a predetermined criteria, such as purchasing a card. (col 2, lns 60-65)

6. In addition, regarding claim 27, the Examiner notes that the recited "if" does not move to distinguish the claimed invention from the cited art. Phrases that contain an "if" are conditional limitations with the noted "if" step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other

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steps are conditionally invocable under certain other hypothetical scenarios.

[See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

7. Regarding claim 28, Toader discloses: The method of Claim 26, wherein said purchase card is provided to the customer manually. (standard marketing techniques in col 2, lns 63-66; col 5, lns 34-38)

8. Regarding claim 30, Toader discloses: The method of Claim 26, wherein said activating comprises providing the customer with a personal identification number associated with said purchase card. (col 5, lns 8-11)

9. Regarding claim 31, Toader discloses: The method of Claim 26, wherein said activating comprises applying a balance (time balance equates credit balance as time buys telephone conversations) to said purchase card. (col 6, lns 40-51; col 7, lns 25-30; col 9, lns 42-43)

10. Regarding claim 32, Toader discloses: The method of Claim 30, further comprising disabling the access capability of the purchase card after a predetermined amount of time. (col 3, lns 48-58; col 4, lns 5-8; col 5, lns 30-34)

11. Regarding claim 33, Toader discloses: The method of Claim 31, further comprising setting to zero the balance (time balance equates credit balance as

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time buys telephone conversations) associated with said purchase card after a predetermined amount of time. (col 3, lns 25-30, lns 48-58; col 4, lns 20-24; col 5, lns 46-50; col 6, lns 31-36)

12. Regarding claim 34, Toader discloses: The method of Claim 26. Toader does not specifically disclose further comprising providing the customer with instructions to visit said web site to activate said purchase card (col 5, lns 4-30). However, it is old and well known that besides phone lines, one can use web sites to register purchasing cards (see Kazacks [0021], [0041], [0046]). Thus, it would have been obvious for one of ordinary skill in the art at the time of the invention to use also a web site to register a purchasing card. This creates more customer convenience.

13. Regarding claim 35, Toader discloses: The method of Claim 26, wherein said survey questions are provided to the customer. (fig 1, elm 11; col 3, lns 33-35; col 4, lns 5-19)

14. Regarding claim 36, Toader discloses: The method of Claim 26, wherein said responses are received from the customer via user interfaces. (fig. 1, elm 5; col 3, lns 33-37; col 5, ln 67 to col 6, ln 8)

15. Claim 29 is rejected under 35 U.S.C. 103(a) as being obvious in view of Toader et al. (US Patent No. 5,749,075) ("Toader"), and of Kazaks et al. (US

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Patent Application Publication No. 2002/0046341) ("Kazaks") as applied to claim 1 above, and in further view of Frazee (US Patent No. 6,829,596) ("Frazee").

16. Regarding claim 29, Toader and Kazaks disclose: The method of Claim 26. The references do not specifically disclose wherein said purchase card is provided to the customer automatically. However, Frazee discloses automatically dispensing purchasing cards by means of vending machines (col 2, ln 42 to col 3, ln 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Toader's and Kazaks' teaching with Frazee's. This combination increases the number of card distribution methods, thus increasing sales numbers and volumes.

### CONCLUSIONS

17. The prior art made of record and not relied upon in this Office action, but considered to be relevant to Applicant's disclosure:

- US 20020169747 A1; Systems and methods for notifying a consumer of changes made to a credit report; Chapman, Thomas F. et al. – *art teaches that purchase cards are issued with preconditions, e.g. good credit history*
- US 5903633 A; Method and apparatus for prepaid phone card activation and billing; Lorsch; Robert H.
- US 20020156725 A1; Method and means for conducting cashless financial transactions; Harara, Marwan Ahmed



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- US 6502745 B1; Pre-paid card system and method; Stimson; Charles J. et al.
- US 20030050043 A1; Method and system for refilling mobile telephone prepaid phone cards via electronic distribution of refill codes; Ohrstrom, Fredrik et al.
- US 20030229583 A1; Methods of coordinating products and service demonstrations; Cotten, Sandra et al.
- US 20040139318 A1; Activation and personalization of downloadable content; Fiala, Barry J. et al.
- US 20040205023 A1; Money transfer convenience card, systems and methods; Hafer, Michael J. et al.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RADU ANDREI whose telephone number is (571)270-5283. The examiner can normally be reached on Mo-Thurs 8am-5pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571.272.6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RADU ANDREI/  
Examiner, Art Unit 4137

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 4137